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In re Application of :  
Bouquet et al :  
Serial No.: 10/657,126 :Decision on Petition  
Filed : September 9, 2003 :  
Attorney Docket No.: 574313-3188.2 :

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on December 3, 2007 requesting withdrawal of the restriction requirement.

**BACKGROUND**

On June 16, 2006, the examiner mailed a restriction requirement in which the original claims 1-33 were divided into 6 groups. This requirement further required election of an apoptotic protein.

On September 18, 2006, Applicants elected Group II (Claims 11-19) and bcl-2 protein with traverse.

On December 11, 2006 the examiner considered the traversal, made the restriction requirement final and mailed to applicants a non-final Office action. The non-final Office action rejected Claim 11 under Double Patenting, and 35 U.S.C. 103.

On March 8, 2007, applicants filed a response to the non-final Office action including a terminal disclaimer.

On June 1, 2007, the examiner mailed to applicants a final Office action maintaining the 103 rejection over at least Claim 11.

On December 3, 2007, applicants filed a response to the Office action along with this petition to request that the Office withdraw the restriction requirement.

On 3 December 2007 applicant filed a request for continued examination.

## DISCUSSION

The petition and file history have been carefully considered.

First, the petition requests that Claim 11 be treated as a linking claim. Claim 11 currently amended, states:

11. (Currently amended) An untransformed, immortalized, avian cell ~~that wherein the~~  
genome of the cell comprises a nucleic acid molecule encoding SV40 T+~~t~~, and wherein the cell  
contains and expresses a nucleic acid molecule encoding an antiapoptotic protein.

The untransformed, immortalized avian cell of Claim 11 is generic to any nucleic acid encoding any antiapoptotic protein. Inventions to an untransformed immortalized avian cell encompassing any particular antiapoptotic protein would be encompassed by claim 11. For this reason, Claim 11 is a linking claim. Although the examination of the elected invention was proper, the restriction requirement may be more clearly written using linking claim practice, as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group IIa. Claim 13, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein wherein the antiapoptotic protein is bcl-2, classified in class 435, subclass 349.

Group IIb. Claim 14, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein wherein the antiapoptotic protein is human adenovirus p19EB, classified in class 435, subclass 349.

Group IIc. Claim 14, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein wherein the antiapoptotic protein is Epstein Barr virus LMP-1, classified in class 435, subclass 349.

Group IId. Claim 14, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein wherein the antiapoptotic protein is Epstein Barr virus BHRF1, classified in class 435, subclass 349.

Group IIe. Claim 14, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein wherein the antiapoptotic protein is baculovirus p35, classified in class 435, subclass 349.

Group IIIf. Claim 14, drawn to untransformed, immortalized avian cells that contain a nucleic acid molecule encoding an anti-apoptotic protein wherein the antiapoptotic protein is herpesvirus ICP34.5, classified in class 435, subclass 349.

Claim 11-12, 16-19, link(s) inventions IIa-IIIf . The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 11-12, 16-19. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such

claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Second the petition requests rejoinder of Claim 14. MPEP 821.04 provides the following guidance on rejoinder practice:

The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder. Rejoinder involves withdrawal of a restriction requirement between an allowable elected invention and a nonelected invention and examination of the formerly nonelected invention on the merits. In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim. A withdrawn claim that does not require all the limitations of an allowable claim will not be rejoined.

The request for rejoinder is premature in view of the outstanding rejection under 35-USC 103(a).

In the event that the generic linking claims, which do not specifically require any particular antiapoptotic protein, Claims 11-12, 16-19, become allowable, rejoinder of non-elected antiapoptotic proteins such as in Claim 14 may be appropriate.

## **DECISION**

The petition is **GRANTED-IN-PART** for the reasons set forth above.

Claim 11 is a linking claim. Should claim 11 become allowable, the examiner will consider rejoinder of any claims, including claim 14, for example, if it required all the limitations of an allowable claim per MPEP 821.04(a).

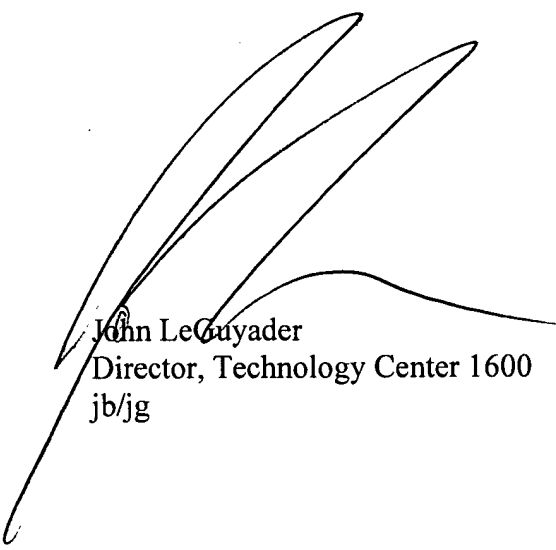
The request for rejoinder has been dismissed as premature.

The case has been forwarded to the examiner for consideration of the papers filed on December 3, 2007.

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above,

or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader  
Director, Technology Center 1600  
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